



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/308,150 09/30/99 VAN VENROOIJ

W 30394-1027

005179 HM22/1010
PEACOCK MYERS AND ADAMS P C
P O BOX 26927
ALBUQUERQUE NM 87125-6927

EXAMINER

DECLLOUX, A

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

10/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/308,150

Applicant(s)
Van Venroooroolj et al.

Examiner
DeCloux, Amy

Group Art Unit
1644



☒ Responsive to communication(s) filed on Sep 30, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-15 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-15 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Serial No. 09/308,150
Art Unit 1644

DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot Program. If you have any questions or suggestions, please contact Paula Hutzell, Supervisory Patent Examiner at paula.hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. Applicant's submission of the instant application as a 371 is acknowledged, however the first claim does not provide a technical feature that is distinguished over the prior art, as evidenced by Schellekens et al. (Arthritis and Rheumatism Vol. 40, No. 9 suppl. 8-12 November 1997)(in IDS) who teaches peptides derived from an antigen that contains a modified arginine and are reactive to antibodies specifically present in rheumatoid arthritis sera (see entire abstract). Therefore, the instant invention lacks Unity of Invention.

2. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

I. Claims 1-4 and 7-9, drawn to a peptide, where said peptide is not cyclic, classified in Class 530, subclasses 300 and 324,

II. Claims 1-3 and 5-7, drawn to a cyclic peptide, classified in Class 530, subclass 317,

III. Claims 10-13, drawn to an antibody, classified in Class 350, subclass 387.1,

IV. Claim 14, drawn to an organic compound, classified in Class 514, subclass 2,
or

V. Claim 15, drawn to a method for the detection of autoimmune antibodies, classified in class 435, subclass 7.1.

Note: The inventions of Claims 1-3 and 7-8 will be examined only to the extent of the elected invention.

Serial No. 09/308,150
Art Unit 1644

3. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

A. Inventions I/II/III/IV and Invention V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the products as claimed can be used in a materially different process such as an antigen to be used in a method of generating antibodies.

B. Inventions I/II/III/IV are unique products. They differ with respect to their structures and physicochemical properties and are therefore patentably distinct.

4. Because inventions I-V are distinct for the reasons given above, and they have acquired a separate status in the art because the searches are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.

5. If Invention I or II is elected, the applicant is required under 35 U.S.C. 121 to elect a **specific peptide**, such as one of the peptides represented by a SEQ ID NOs:1-7, as recited in claim 4.

6. If Invention III is elected, the applicant is required under 35 U.S.C. 121 to elect a **specific peptide** to which the recited antibody is directed, such as one of the peptides represented by a SEQ ID Nos:1-7, as recited in claim 4.

7. If Invention IV is elected, the applicant is required under 35 U.S.C. 121 to elect a **specific peptide** to which the recited organic compound competes, such as one of the such as one of the peptides represented by a SEQ ID Nos:1-7, as recited in claim 4.

8. If Invention V is elected, the applicant is required under 35 U.S.C. 121 to elect a **specific immunologically reactive molecule** to be used in an immunological test, such as one of the peptides represented by a SEQ ID NOs:1-7, as recited in claim 4, or a specific antibody, or a specific organic compound.

9. The species are distinct each from the other for the following reasons:

The recited peptides, antibodies, immunologically reactive molecules and compounds listed differ with respect to their structure, and accordingly have different

Serial No. 09/308,150
Art Unit 1644

biochemical characteristics, structure and functions.

10. Applicant is required, in response to this action, to elect a specific species to which the claims shall be restricted if no generic claim is finally held to be allowable. The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

11. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

12. The following claim(s) are generic: claims 1, 10, 14 and 15.

13. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

14. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Serial No. 09/308,150
Art Unit 1644

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Amy DeCloux, Ph.D.
Patent Examiner
Group 1640
October 7, 2000

Phillip Gambel
PHILLIP GAMBEL, PH.D
PRIMARY EXAMINER
TECHNOLOGY CENTER 1600
10/4/00